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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,088	12/11/2003	Stanford R. Ovshinsky	2090	8463
24963	7590	09/08/2006	EXAMINER	
ENERGY CONVERSION DEVICES, INC. 2956 WATERVIEW DRIVE ROCHESTER HILLS, MI 48309			NGUYEN, CAM N	
			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/733,088	OVSHINSKY, STANFORD R.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cam N. Nguyen	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06/23/06 (an amendment/response & RCE).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,4-8 and 11-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,6-8,20 and 21 is/are allowed.
- 6) ☒ Claim(s) 4,5 and 11-18 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 19 and 22-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on originally filed is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Response to status of an RCE application**

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 06/23/06 has been entered.

### **Response to Amendment**

2. Applicants' amendment and remarks, filed June 23, 2006, has been made of record and entered. Claim 1 has been amended. Claims 2-3 & 9-10 have been canceled. Claims 20-25 have been added.

Claims 1, 4-8, & 11-25 are currently pending and under consideration.

### **Specification**

3. The abstract of the disclosure is objected to because it is not a single paragraph format and it is too long. Correction is required. See MPEP § 608.01(b).

### **Claim Objections**

4. Claims 19 & 22-25 are objected to because of the following informalities:

A. In claim 19, line 2, --an assembly of atoms of-- should be inserted before "two".

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- B. In claim 22, line 2, --of an assembly of atoms-- should be inserted after “essentially”.
- C. In claim 23, line 2, --of an assembly of atoms-- should be inserted after “essentially”.
- D. In claim 24, line 2, --of an assembly of atoms-- should be inserted after “essentially”.
- E. In claim 25, line 2, --of an assembly of atoms-- should be inserted after “essentially”.

Appropriate correction is required.

5. Claims 4 & 5 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 1 recites the phrase “said atomic aggregations consisting essentially of an assembly of atoms of one or more metal elements”, but claims 4 & 5 recite the phrase “comprise”. The limitations of claims 4 & 5 appear to be broader than the limitation recited in claim 1.

**Claim Rejections - 35 USC § 112 (Second Paragraph)**

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4, 5, & 11-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Regarding claims 4 & 5, it is unclear as to whether the transition metal and the Fe, Mg, V, or Co recited in these claims are in addition to the “one of more metal elements” required in

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claim 1. If so, then the claims should be amended to recite --further--. Thus, the claims are vague and indefinite.

B. Regarding claim 11, same reason as in A above. If the Mg is not an element in addition to the metal(s) required in claim 1, then the claim should be recited --consists essentially of--.

### **Response to Applicants' Arguments**

8. Applicants' response filed on June 23, 2006 has been fully considered, but not deemed persuasive in view of the new ground of rejection(s) and/or objection(s) above.

### **Conclusion**

9. Claims 1, 4-8, & 11-25 are pending. Claims 4, 5, & 11-18 are rejected. Claims 4, 5, 19, & 22-25 are objected. Claims 1, 6-8, 20, & 21 are allowed.

### **Contacts**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Nguyen/cnn

Primary Examiner

September 04, 2006

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